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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,888	04/06/2001	Hisashi Hotta	003510-091	3377

7590

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1752

5

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09-826,888

Applicant(s)

Hotta

Examiner

Cynthia Hamilton

Group Art Unit

1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7-31-01, 4-6-01, 4-6-01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above claim(s) none is/are withdrawn from consideration.
- ☒ Claim(s) 1 is/are allowed.
- ☒ Claim(s) 2-21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The drawing(s) filed on 4-6-02 is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, (ii), the property set forth is confusing because the plate claimed is a recording layer writable by laser exposure but the property of a contact angle of "a non-image area" after a developing process is directed a different plate, i.e., the plate after non specified development steps. Further, there is reference to "exposed" microspores but it is not clear when such exposure occurs. Is this reference to pores exposed by laser or physically exposed after development? Without guidance as to the nature of "development" is a worker of ordinary skill in the art to determine how the property of a surface after development will fit the unimaged plate? Thus, these properties are too vaguely described in the claim language as to guide the worker of ordinary skill in the art to a clear understanding as to what is claimed.

3. The examiner notes for the record applicants in claim 2 have measured the density of anodic oxidation in both kg/m^2 and g/cm^2 . There is no issue of lack of clarity here.

4. The examiner notes for the record that "thermal type photosensitive layer" is defined by applicants on page 22 of the instant specification as "a layer that is directly writable by irradiation with an infrared laser beam and in which solubility of the irradiated area of the layer

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to an alkali developer is changed ...” This is inclusive of those which become more soluble or less soluble in alkali developer.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In figure 1, TF is not defined. In Figure 2, the following symbols are not defined in the specification; 16, 18, 20, 13b, 10, 19, 11, 13a, 17, 14, 22b, 15, w, 22a, and 12. The Examiner also note that if applicants use the words near each number or letter to put descriptions in the specification then 16 has conflicting descriptions; i.e. auxiliary anode and slit. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The examiner notes for the record that EP 0697282 cited by applicants discloses aluminum oxide layers of a density of a minimum of $5000,000 \text{ kg/m}^3$, i.e., a thickness of $2.0\mu\text{m}$ and 1g/m^2 , as outside ranges of defined layer to determine density. All other density values in the ranges given would be higher. The same is true of EP 0716935A and EP 0730202. The calculation used was $(1\text{g/m}^2) (1/2\mu\text{m}) (1\text{kg}/1000\text{g}) (1 \times 10^9 \mu\text{m}/\text{m}) = 500,000 \text{ kg/m}^3$ by this examiner. The thickest layer and lightest weight would give the least dense layer cited by the prior art. The same calculations for WO 9852743A yield $155,000 \text{ kg/m}^2$ density. Thus, it, too, is outside the instant ranges.

Thus, the prior art cited in the equivalent European Search Report does not appear to read on the instant invention.

7. Claim 1 is allowed.

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

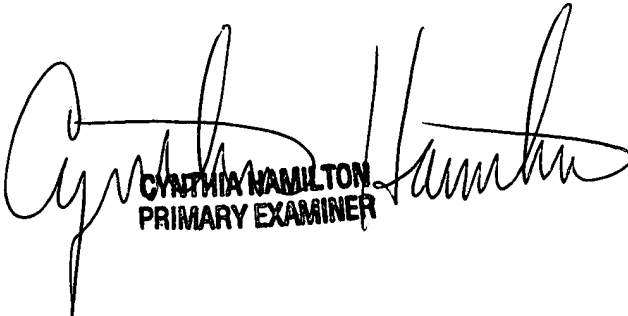
Takahashi et al (5,569,573) teach the instant problem of staining due to heat fusible resin on the surface. See particularly in Takahashi et al col. 1, lines 54-57. They do not vary the aluminum oxide layer to address this problem.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cynthia Hamilton whose telephone number is 703-308-3626. The examiner can normally be reached on Monday - Friday, 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet J. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of paper not received regarding this communication or earlier communications, or of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Center of Technology Center 1700 whose telephone number is 703-306-5665.

C. Hamilton/mn
December 31, 2002


CYNTHIA HAMILTON
PRIMARY EXAMINER